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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,254	02/22/2000	HERMANN WAGNER	C1041/7005	6183

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HELEN C LOCKHART  
WOLF GREENFIELD & SACKS  
FEDERAL RESERVE PLAZA  
600 ATLANTIC AVENUE  
BOSTON, MA 02210-2211

EXAMINER

ZARA, JANE J

ART UNIT

PAPER NUMBER

1635

31

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

File

**Office Action Summary**

Application No.

09/355,254

Applicant(s)

Wagner et al

Examiner

Jane Zara

Art Unit

1635



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Jul 7, 2003
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-29 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other:  |

File

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### **DETAILED ACTION**

This Office action is in response to the communication filed July 7, 2003, Paper No. 30.

Claims 24-29 are pending in the instant application.

Upon further consideration, the indication of allowability of claims 24-29 is hereby withdrawn and new grounds of rejections are set forth in the Office action as indicated below.

#### ***Response to Arguments and Amendments***

Any rejections not repeated in this Office action are hereby withdrawn.

#### **New Rejections**

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was

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not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 24 and 28 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Hinrichs et al.

Hinrichs et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 8 and a pharmaceutically compatible diluent (e.g. water), whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See especially the abstract and SEQ ID NO: 2 of Hinrichs et al and the accompanying sequence alignment data).

Claims 24, 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolganov et al.

Dolganov et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 9 and a pharmaceutically compatible diluent (e.g. water), whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See especially figure 2 on page 3319 and the accompanying sequence alignment data).

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Claims 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Stanford et al.

Stanford et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 17 and a pharmaceutically compatible diluent (e.g. water), whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See especially figure 2 on page 409, last two paragraphs on page 410, and the accompanying sequence alignment data).

Claims 24 and 28 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Levy et al.

Levy et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 19 and a pharmaceutically compatible diluent (e.g. water), whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See especially the abstract and SEQ ID NO: 12 of Levy et al and the accompanying sequence alignment data).

Claims 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al.

Green et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 13 and a pharmaceutically compatible diluent (e.g. water), whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See especially the

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abstract, page 3, pages 13-18, Accession No. AAT32689 of Green et al and the accompanying sequence alignment data).

Claims 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono et al.

Ono et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 12 and a pharmaceutically compatible diluent (e.g. water), whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See especially the abstract, example 4 on page 42, and Accession No. AAT18820 of Ono et al and the accompanying sequence alignment data).

Claims 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Cha et al.

Cha et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 22 and a pharmaceutically compatible diluent (e.g. water), whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See especially the figure 1 on page 5281, figure 3 on page 5282, Accession No. L24442 of Cha et al, and the accompanying sequence alignment data).

Claims 24 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Harada et al.

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Harada et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 11 and a pharmaceutically compatible diluent (e.g. water), whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See especially the abstract, col. 2-5, col. 25-26, SEQ ID NO: 2 of Harada et al and the accompanying sequence alignment data).

Claims 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al.

Davis et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 10 which further comprises a phosphorothioate internucleotide linkage, and which compositions further comprises a peptide or polysaccharide antigen, and a pharmaceutically compatible diluent, whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See entire document, especially the abstract, col. 3-6, col. 26-30, SEQ ID NO: 89 of Davis et al, and the accompanying sequence alignment data).

Claims 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by McKnight et al.

McKnight et al teach a pharmaceutical composition comprising the polynucleotide sequence of SEQ ID NO: 21 and a pharmaceutically compatible diluent (e.g. water), whereby the polynucleotide comprises a binding site for a transcription factor of a cytokine (See especially the

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abstract, col. 10, claims 1-3, and SEQ ID NO: 3 of McKnight et al, and the accompanying sequence alignment data).


### ***Conclusion***

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(703) 306-5820**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (703) 308-0447. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (703) 305-3413. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

**JZ**

July 16, 2003

  
**RAM SHUKLA**  
**PRIMARY EXAMINER**